

Application No. 10/692,917

Reply to Office Action

REMARKS

RECEIVED
CENTRAL FAX CENTER

AUG 08 2006

Discussion of Claim Amendments

Claims 1 has been amended to include the subject matter of claim 13. Claim 14 has been amended to make it depend on claim 1. No new matter has been added.

The Office Action

The Office Action sets forth the following grounds for rejection:

1. Claims 1-3, 5, 7, 12, 17-22, and 25-26 are rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. (US 2003/0227531) in view of Doi et al. (US 6,988,795);
2. Claim 4 is rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Santilli et al. (USP 5,738,716);
3. Claim 6 is rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Doi and further in view of Zhu et al. '933 (US 6,221,933);
4. Claims 8-11 are rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Doi and further in view of Mead et al. (US 5,596,027);
5. Claims 1-3, 5-17, and 20-26 are rejected under 35 USC § 103(a), as allegedly unpatentable over Zhu et al. '933 in view of Mead et al. and Zhu et al. '495 (US 2004/0154495);
6. Claim 4 is rejected under 35 USC § 103(a), as allegedly unpatentable over Zhu et al. '933 in view of Mead et al. and Zhu et al. '495 and further in view of Wu et al. (US 2003/0144375);
7. Claims 1-3, 5, 7, 12-22, and 25-26 are rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Zhu et al. '495;
8. Claim 4 is rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Zhu et al. '495 and further in view of Santilli et al.;
9. Claim 6 is rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Zhu et al. '495 and further in view of Zhu et al. '933; and
10. Claims 8-11 are rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Zhu et al. '495 and further in view of Mead et al.

Application No. 10/692,917

Reply to Office Action

*Discussion of Obviousness Rejections*1. Rejections 1-4

Hosoi et al. has been cited as the primary reference. The Office admits that Hosoi et al. fails to disclose the requirement in the present claims of specific conductivity agent. The Office, however, states that Doi discloses the use of a hydrophobic conductive agent such as calcium hydroxide. The Office argues that it would have been obvious to one of ordinary skill in the art to use such conductivity agent in the ink of Hosoi et al. in order to produce the ink jet ink of the claimed invention.

Although applicants disagree with the rejection, applicants have amended the claims to expedite prosecution of the application. The subject matter of claim 13, which was not rejected over the combination of Hosoi et al. and Doi, has been incorporated into claim 1. Applicants respectfully submit that the presently claimed invention is not suggested to those of ordinary skill in the art by Hosoi et al. and Doi. Santilli et al., Zhu et al. '933, and Mead et al. do not fail to cure the deficiencies of Hosoi et al. and Doi. In view of the foregoing, the rejections should be removed.

2. Rejections 5-10

In these rejections, Zhu et al. '495 has been cited as one of the references. Zhu et al. '495 published from U.S. Patent Application No. 10/775,979. Zhu et al. '495 qualifies as prior art only under 35 USC § 102(e), (f), or (g). Applicants herein provide a statement of common ownership to disqualify the '979 application as prior art under 35 USC § 103(c).

Statement of Common Ownership

The present application and the '979 application were, at the time the invention of the present application was made, owned by Videojet Technologies Inc.

In view of the foregoing, the '979 application should be removed as prior art. The remaining references fail to suggest to those of ordinary skill in the art the presently claimed invention. Accordingly, the rejections should be withdrawn.

Application No. 10/692,917

Reply to Office Action

Conclusion

A favorable decision is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Xavier Pillai, Reg. No. 39,799
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: August 8, 2006